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IN THE

Supreme Court of the United States

OCTOBER TERM, 1980

SIDNEY A. DIAMOND,
COMMISSIONER OF PATENTS AND TRADEMARKS,
Petitioner,

v.

JOHN J. BRADLEY AND BENJAMIN S. FRANKLIN,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

REPLY BRIEF FOR THE RESPONDENTS

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The Respondents' Reply Brief is necessitated by the mischaracterization of the issue before this Court by the Commissioner in his Reply Brief for the Petitioner.

The Commissioner in his Reply Brief has changed his position from that taken in his Brief for the Petitioner, has misrepresented the Respondents' position, and has misconstrued the Respondents' invention. Notwithstanding this obfuscation by the Commissioner, the issue before the Court is whether the Respondents' invention is a machine as that term is used in 35 U.S.C. 101. The issue is *not* the novelty of the Respondents' invention under 35 U.S.C. 102 or 35 U.S.C. 103.

A. THE COMMISSIONER HAS CHANGED HIS CHARACTERIZATION OF RESPONDENTS' INVENTION IN HIS REPLY BRIEF FROM THAT PRESENTED IN HIS BRIEF FOR THE PETITIONER.

On page 5 of his Brief for the Petitioner the Commissioner characterizes Figures 15b and 15c as flow charts for a microprogram, yet on pages 2 and 3 in his Reply Brief, the Commissioner changes his position and argues that Figures 15b and 15c include hardware previously described by the Carre application and the Coulter patent. The disclosures of Carre or Coulter *do not* include Figures 15a, 15b, and 15c and the accompanying description included in Respondents' application. The Commissioner, therefore, is incorrect in alleging that the Respondents' hardware invention is disclosed in Carre and Coulter.

B. THE COMMISSIONER STILL HAS NOT DEFINED OR IDENTIFIED ANY PROGRAM IN THE RESPONDENTS' APPLICATION BUT INSISTS ON CALLING THE "RULE OF ACTION OF THE MACHINE" A PROGRAM.

All machines have a rule of action. (See Brief for The Respondents, pg. 12, footnote 40). The rule of action is embodied in hardware. A simple example will make this clear.

Take an ordinary electric circuit comprising only a light bulb and electric switch. Certainly, this is the type of device that is eligible for patent protection under 35 U.S.C. 101.

Let us now add a cam which engages the light switch, and a motor for turning that cam at predetermined speeds. The cam engages the light switch to turn the light on and off as it rotates.

We now have an entirely new machine - a stroboscope. The rotation of the cam can be set to turn the light on and off at the speed of a bullet fired from a gun. When this is done, the stroboscope "freezes" the motion of the bullet and a clear picture of it can be taken. (Professor Edgerton of MIT has made many such pictures using a stroboscope.)

The rule of action of this machine is embodied in the cam. The cam may be likened to firmware in a computer. As a matter of fact, the cam in this stroboscope could be replaced by firmware. Can it now be said that the stroboscope is not eligible for patent protection merely because firmware has replaced the cam? The answer is obvious - it is the type of invention that the patent laws were enacted to protect — it is a machine as that term is used in 35 U.S.C. 101.

The Respondents' invention although infinitely more complex is similar in that the rule of action is embodied in the claimed hardware combination.

C. THE COMMISSIONER MUST CITE PRIOR ART UNDER 35 U.S.C. 102 OR 35 U.S.C. 103 TO SHOW IN WHAT RESPECTS A HARDWARE ARRANGEMENT IS OLD.

There is no issue of novelty under 35 U.S.C. 102, 103 present in this case as alleged by the Commissioner. Even if such issue were present the Commissioner is merely relying on a bare allegation on page 2 of his Reply Brief to support his position that the Respondents' hardware combination is old. He has cited no prior art on the record to show that "the hardware arrangement, as well as each component" is old nor has he shown how such components cooperate and function with each other to produce the improved result of Respondents' invention. Allegations are not "findings" as stated by the Commissioner. The Commissioner is clearly erroneous in stating that an allegation is a finding.

Despite the fact that there is no issue of novelty under 35 U.S.C. 102, 103 before this Court the Commissioner is using the Respondents' own disclosure to allege that Respondents' invention is old under 35 U.S.C. 102 or 35 U.S.C. 103. The Commissioner attempts this by reconstructing the Respondents' invention to fit within the disclosures of Carre and Coulter. The Commissioner by hindsight is utilizing the Respondents' invention to infer the disclosure of a gate in Coulter. Even if such a gate were present in Coulter and Carre (which is not admitted by the Respondents), there is no disclosure in Carre or Coulter to show how it cooperates and functions with other hardware elements in a similar manner as the Respondents' invention to achieve the improved results. Such hindsight reconstruction of the invention and the use of the Respondents' own disclosure as prior art is clearly erroneous and contrary to established law.

D. THE COMMISSIONER IMPLIEDLY ADMITS THAT HE IS UTILIZING NOVELTY REQUIREMENTS TO REJECT COMPUTER RELATED INVENTIONS UNDER 35 U.S.C. 101.

In answer to an amicus statement that the Government for its own convenience seeks a per se rule that computer related inventions are unpatentable the Commissioner replied as follows:

> "We have never intended, however, that a new digital computer, or a computer related invention, is unpatentable when it involves an inventive novelty in its type or arrangement of hardware."

Novelty is a 35 U.S.C. 102 or 103 requirement and not a 35 U.S.C. 101 requirement. Consistent with this Court's decisions, Flook, Benson and Chakrabarty, 35 U.S.C. 101 requires a man-made machine or improvement thereof which has not always existed. When these criteria are met the invention is then statutory subject matter under 35 U.S.C. 101 and is eligible for examination of novelty under 35 U.S.C. 102 and 103. Respondents' invention meets these criteria.

E. THE COMMISSIONER IN ATTEMPTING TO IMPORT 35 U.S.C. 102 AND 103 REQUIREMENTS TO SHOW THE SIMILARITY BETWEEN THE COULTER PATENT AND THE BRADLEY INVENTION ADMITS THAT THE INVENTION IS PATENTABLE SUBJECT MATTER UNDER 35 U.S.C. 101.

It is improper to import 35 U.S.C. 102 and 103 prior art factual considerations into 35 U.S.C. 101. Both the Carre

application, U.S. Serial Number 528,951 and the Coulter patent, U.S. Patent Number 3,891,874, issued June 24, 1975, were called to the attention of the Commissioner during prosecution by the Respondents. (See J.A. p. 25, Ref. 15 and J.A. p. 136.) The Commissioner chose not to cite these documents under 35 U.S.C. 102 or 103, and thereby precluded the establishment of a factual record regarding issues of novelty and prior invention.

The Respondents stand by their argument in the Brief for Respondents, pps. 38-42. The Commissioner by alleging that the Respondents' invention is similar to the invention of Coulter and Carre is admitting thereby that Respondents' invention is the type that the Patent Laws were enacted to protect. The invention is therefore a machine as that term is used in 35 U.S.C. 101.

F. THE COMMISSIONER HAS MISREPRESENTED THE RESPONDENTS' POSITION.

The Commissioner has erroneously misrepresented the Respondents' position to this Court (refer to Reply Brief of the Petitioner, p. 4, paragraph 2, lines 3-6). Contrary to the Commissioner's misrepresentation, the Respondents are on record as indicating that a new program in a conventional computer does not create a new machine. (Refer to Respondents' Brief in Opposition to a Writ of Certiorari to the United States Court of Customs and Patent Appeals, p. 9, first full paragraph). This is not an issue.

The Commissioner additionally misrepresents the Respondents' position in response to Respondents' statement that the introduction of the Carre application and the Coulter patent is improper under Rule 21.1a of the Rules of

this Court. The Commissioner now alleges that it is the Respondents who have raised the issue of novelty of their invention (refer to Footnote 1, page 3 of the Reply Brief for the Petitioner). This is not true. Furthermore, there is no basis for this position in those portions of Respondents' Reply Brief cited by the Commissioner. The correct facts are that the court below stated that issues of novelty and non-obviousness were not before it (refer to J.A. 18). It agreed with respondents in that their invention is a machine or apparatus, and that the claims fall "literally within the boundaries of 35 U.S.C. 101." (J.A. 18).

In view of the established record, the Commissioner's basis for attempting to reintroduce the question of novelty is inaccurate, without support and improper under the Rules of this Court (i.e., Rule 21.1a).

G. THE COMMISSIONER HAS ADMITTED THAT HE WANTS THIS COURT, *NOT* CONGRESS TO DECLARE A PER SE RULE THAT COMPUTER PROGRAMS AND COMPUTER RELATED INVENTIONS ARE NOT PATENTABLE.

The Commissioner by his comments in his Reply Brief (Commissioner's Reply Brief, paragraph 4, pp. 6-7) has tacitly admitted that for his own convenience he seeks a per se rule that computer programs and computer related inventions are unpatentable. As this Court has unequivocally stated in both *Benson* and *Flook,* such policy issues are for Congress to decide - not the Court.

For the reasons stated herein and in Respondents' main Brief, the judgement of the Court of Customs and Patent Appeals should be affirmed.

Respectfully submitted,

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